

obtain prompt allowance. Commercial embodiments of some of the claimed inventions are currently on the market; and unauthorized, infringing activity is believed to be occurring, at least on a small scale. The prompt allowance of a patent having Claims that would cover both the commercial embodiments and the suspected infringements could help to protect the Applicant's rights, before infringing activity became more widespread.

The current amendments are intended to satisfy the substance of the various objections raised in the June 3, 2004 Office Action. It is accordingly hoped that this Amendment will result in the prompt allowance of the pending Claims. In the alternative, should the Examiner identify any remaining issues, the Examiner is respectfully requested to contact the undersigned to schedule a telephone interview before further action is taken, to discuss whether it might be possible to resolve any such issues quickly, and to conclude the prosecution of this application.

The Examiner clarified in a March 1, 2005 telephone conversation with the undersigned that the October 4, 2004 amendment had not been entered. Therefore, the changes marked in the claim amendments below are changes as compared to the most recent amendment prior to October 4, 2004, namely, the May 13, 2003 amendment.

Remarks

Claims 62 and 71 have been amended. Claims 70, 73, and 75-81 have been canceled. Claims 82-84 have been added.

Claims 62-69, 71-72, and 82-84 remain in the application.

Claims 63, 65, 67, 69, and 71 have been held to be withdrawn from consideration.

Basis for the amendments to Claim 62 appears, for example, in the specification at page 28, lines 2-6; page 30, lines 18-26; and page 11, lines 7-21 (as amended).

Basis for the amendments to Claim 71 appears, for example, in the specification at page 28, lines 2-6; page 30, lines 18-26; and page 11, lines 7-21 (as amended).

Basis for new Claims 82-84 appears, for example, in the specification at page 6, lines 23-31.

Reexamination and reconsideration of the application, as amended, are respectfully requested.

2. The Non-Elected Process Claims Should be Rejoined After the Product Claims Have Been Allowed

Applicant respectfully submits that once the elected Claims to the rice plants have been allowed, the non-elected Claims directed to processes for making and using the rice plants should then be rejoined and examined in the same application. In particular, the Office's attention is respectfully directed to M.P.E.P. § 821.04, which provides for rejoinder of process Claims in such a case.

Note particularly that rejoinder under M.P.E.P. § 821.04 does not depend upon whether the original election was made with or without traverse.

Applicant interprets the Office's June 3, 2004 comments on this point as agreeing with Applicant's position in principle.

New Claims 82-84 correspond to Group III, as identified in the December 11, 2002 Restriction Requirement.

7. The Written Description Rejection

Claims 62, 64, 66, 68, 70, 75, 77, 79, and 81 were rejected as containing subject matter that lacked an adequate written description in the specification. Claims 75, 77, 79, and 81 have been canceled.

The basis for this rejection was that the Claims encompass "a myriad of mutations within multiple AHAS encoding genes within a rice plant and said herbicide-resistant rice plant could be produced by any of a multitude of methods" (June 3, 2004 Office Action, p. 7.) While not conceding this point, it is

respectfully submitted that the present amendment overcomes the grounds given by the Office for the written description rejection. Claim 62, the independent Claim of Group I, has been revised to now refer to a rice plant resulting from a process for breeding herbicide resistant rice plants, by crossing or back-crossing with the herbicide resistant rice plant PTA-904.

It is respectfully submitted that the written description rejection should be withdrawn.

8. The Enablement Rejection

Claims 62, 64, 66, 68, 70, 75, 77, 79, and 81 were rejected as containing subject matter that was not enabled by the specification. Claims 75, 77, 79, and 81 have been canceled.

The rationale for the enablement rejection is not fully understood.

Nevertheless, it is respectfully submitted that the present amendment to independent Claim 62 should overcome any enablement concerns. Claim 62 has been revised to now refer to a rice plant resulting from a process for breeding herbicide resistant rice plants, by crossing or back-crossing with the herbicide resistant rice plant PTA-904. The rice plant PTA-904 is enabled by virtue of its deposit with ATCC. Crossing and back-crossing breeding techniques are notoriously well-known in the plant breeding art. A person of ordinary skill in the art, given the teachings of the present specification, and given the ATCC patent deposit, would readily be able to practice the invention of independent claim 62 without undue experimentation.

It is respectfully submitted that all grounds of rejection pertaining to enablement should be withdrawn.

9 and 10. The § 102(b) and § 103 Rejections

Claims 62, 64, 66, 68, 70, 75, 77, and 79 were rejected under 35 U.S.C. § 102(b) or § 103 as being anticipated by or obvious over Terakawa, in some cases in combination with Dietrich. Claims 75, 77, and 79 have been canceled.

For the reasons given in the May 13, 2003 Amendment – reasons that will not be repeated in the interest of brevity – it is respectfully submitted that the prior art rejections should be withdrawn. For the reasons given in that Amendment, it is respectfully submitted that the Terakawa paper on its face is clearly distinguishable from the claimed inventions. Applicant continues to urge this position, and the discussion appearing below should not be construed to the contrary.

Nothing in either cited reference teaches or suggests the rice plant PTA-904, nor its surprising levels of herbicide resistance, nor its use in breeding. It is respectfully submitted that the prior art rejections should be withdrawn.

11. The Obviousness-Type Double Patenting Rejection

Claims 62, 64, 66, 68, 70, 75, 77, 79, and 81 were rejected for obviousness-type double patenting over Claims 1-9 of Croughan, U.S. Patent 5,773,704. Claims 75, 77, 79, and 81 have been canceled.

For the reasons given in Applicant's prior Amendments, it is respectfully submitted that the obviousness-type double patenting rejection should be withdrawn.

Furthermore, nothing in the cited '704 patent suggests the rice plant PTA-904, nor its surprising levels of herbicide resistance, nor its use in breeding. Even if the Office did not accept Applicant's prior arguments concerning double patenting, it is respectfully submitted that the present amendments overcome this ground of rejection.

It is respectfully submitted that the obviousness-type double patenting rejection should be withdrawn.

The 37 C.F.R. § 1.121(c) Objection

The December 22, 2004 USPTO Communication also stated that "claims 63, 65, 67, 69, 71, and 72 do not comply with 37 CFR § 1.121(c). Appropriate correction is required. See 37 CFR § 1.111." No further explanation was given.

It is respectfully submitted that all claim amendments in this application have fully complied with 37 C.F.R. §§ 1.111 and 1.121(c). If the Office disagrees, then the Office is respectfully requested to specify the basis for this objection in greater detail, so that a more responsive reply may be made. Otherwise, it is respectfully submitted that this objection should be withdrawn.

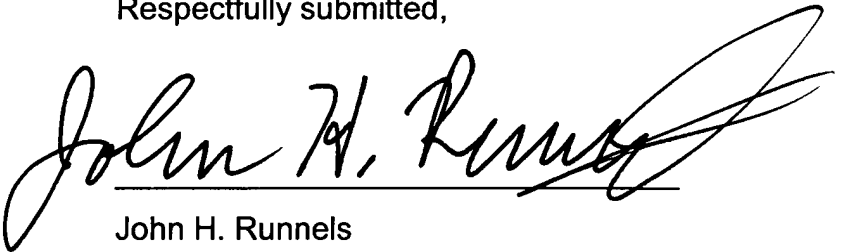
Conclusion

The Office is respectfully requested to withdraw the December 22, 2004 Office Action.

Allowance of all pending Claims at an early date is respectfully requested.

In the alternative, should the Examiner identify any remaining issues, the Examiner is respectfully requested to contact the undersigned to schedule a telephone interview before further action is taken, to discuss whether it might be possible to resolve any such issues quickly, and to conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, reading "John H. Runnels", is written over a horizontal line. The signature is stylized with a large, sweeping initial "J" and a long, horizontal stroke at the end.

John H. Runnels
Taylor, Porter, Brooks & Phillips, L.L.P.
P.O. Box 2471
Baton Rouge, LA 70821
(225) 381-0257

Registration No. 33,451

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